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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,579	08/25/1999	MICHAEL MEYRICK BURRELL	9341-018-999	6768

7590

09/24/2003

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EXAMINER

BAUM, STUART F

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 09/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/383,579

Applicant(s)

BURRELL ET AL.

Examiner

Stuart F. Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 6/30/2003 has been entered.

Claims 19-36 are pending.

Claims 1-18 have been canceled.

Claims 19-36 have been newly submitted.
2. In view of the cancellation of all of the previously restricted claims and the newly submitted claims, a supplemental restriction is warranted. Applicant has elected with traverse the claims of Group I. It is noted that Applicant has not elected a sequence even though the restriction mailed 3/26/2003 required Applicant to elect one sequence from a list.
3. Objection is made to claim 1 which specifies a DNA sequence by the term Ex29. 37 CFR 1.821(d) requires the use of the assigned sequence identifier (e.g. SEQ I.D. NO: X) in all instances where the description or claims of a patent application discuss sequences.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 19-23, 31, and 34-36, drawn to a method of transforming trees to modify the fibre characteristics in trees comprising transforming said plant with any chimeric gene comprising a promoter operably linked to a nucleic acid sequence in sense orientation encoding an expansin capable of modifying at least one of:

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fiber cell wall extension, tree height or internode length, classified in class 800, subclass 290 for example.

- II. Claims 19 and 22, drawn to a method of transforming trees to modify the fibre characteristics in trees comprising transforming said plant with any chimeric gene comprising a promoter operably linked to a nucleic acid sequence in antisense orientation wherein said sequence is capable of modifying at least one of: fiber cell wall extension, tree height or internode length, classified in class 800, subclass 290 for example.
- III. Claims 24-30, and 32-33, drawn to a nucleic acid sequence and chimeric gene comprising said nucleic acid sequence, classified in class 536, subclass 23.1 for example.

For the election to be complete, Applicant is required to elect one sequence from the following list and to specify if the sequence is from *Eucalyptus* or cucumber:

SEQ ID NO:1;	SEQ ID NO:2;	SEQ ID NO:3;
SEQ ID NO:4;	SEQ ID NO:5;	SEQ ID NO:6.

5. Inventions I through III are unrelated to each other. The method of transforming a tree to modify fiber characteristic of Group I does not require the antisense molecules associated with the method of Group II.
6. Inventions I-II, and III are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions are distinct because the starting materials, methods steps and end products are distinct and unrelated to each other. Examples of divergent method steps are the specific temporal, spatial and quantitative expression patterns required to modify fiber characteristics which are different than the expression patterns associated with plant transformation of Group III.

7. Sequences 1-6 are unrelated to each other. Applicant is reminded that nucleotide sequences either encoding different proteins or specifying specific expression patterns are structurally distinct chemical compounds and are unrelated to one another, as are different proteins structurally distinct chemical compounds and unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434). This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

8. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

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9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart F. Baum whose telephone number is 703-305-6997. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Stuart F. Baum Ph.D.

September 17, 2003


PHUONG T. BUI
PRIMARY EXAMINER 9/19/03